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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/159,404	09/24/1998	CURTIS T. COMBAR	COS-98-044	5086

25537 7590 04/16/2004

WORLDCOM, INC.
TECHNOLOGY LAW DEPARTMENT
1133 19TH STREET NW
WASHINGTON, DC 20036

EXAMINER

HAYES, JOHN W

ART UNIT PAPER NUMBER

3621

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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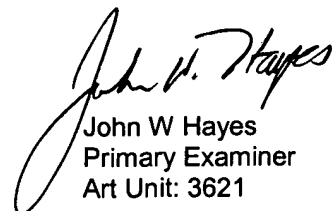
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Commissioner for Patents

As a result of a telephone conversation with Mr. Brian Oaks, it was brought to the examiner's attention that the Advisory Action mailed on 18 February 2004 incorrectly indicated that the After Final amendment filed 26 January 2004 would not be entered for purposes of appeal. Thus, examiner is providing a corrected Advisory Action to properly indicate that the After Final amendment should be entered for purposes of appeal since the amendment removes issues for appeal.


John W Hayes
Primary Examiner
Art Unit: 3621

Advisory Action

Applicati n N .

09/159,404

Applicant(s)

COMBAR ET AL.

Examiner

John W Hayes

Art Unit

3621

--The MAILING DATE of this communication appears n the cover sh t with the corresp nd nce address --

THE REPLY FILED 26 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 25 February 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

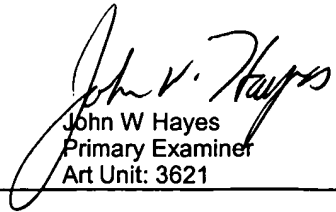
Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-19.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


John W Hayes
Primary Examiner
Art Unit: 3621

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's have essentially repeated arguments previously submitted which have been responded to by the examiner. More specifically, Chang discloses that the typed inputs are sent to a server as a request to receive various reports relating to their service (Col. 7, lines 5-12). Chang further discloses that in response to other inputs from the subscriber, the system collects service reporting information and then formats this data for transmission and display to the customer's terminal (Col. 23, lines 10-27). Thus, examiner's position is that Chang does teach, as applicant asserts, inputting information for transmission over the Internet, however, this information is transmitted by the customer and is a request for information to be reported back to the customer. Examiner would also like to point out that the courts have reviewed the law of claim interpretation at some length, and explained that dictionaries, encyclopedias and treatises are reliable and objective resources available to assist the court in determining the ordinary and customary meaning of claim terms. See *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 64 USPQ2d 1812 (CAFC 2002) and *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 65 USPQ2d 1961, 1965 (Fed. Cir. 2003). Recent decisions have indicated that if an inventor is relying on a special meaning for terms appearing in the claims, then the special meaning must be clearly written in the specification. "Although an applicant may be his own lexicographer... nothing in the specification defines the phrase 'speech user agent' differently from its ordinary meaning", see *In Re Thrift*, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002). "One purpose for examining the specification is to determine if the patentee has limited the scope of the claims.' ...For example, an inventor may choose to be his own lexicographer is he defines the specific terms used to describe the invention 'with reasonable clarity, deliberateness, and precision', see *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002) and *In re Paulsen*, 31 USPQ2d 1671, 1674-75 (Fed. Cir. 1994). Thus, examiner submits that it is proper to rely on a dictionary meaning of the term "metadata" as it applies in the context of the claim language. Examiner interprets the "typed inputs" of Chang to teach "metadata" since the "typed input" is information entered by the customer to describe information that is being requested. Therefore, the after final amendment filed 26 January 2003 will not be entered at this time and will only be entered if this application is appealed to the Board of Patent Appeals and Interferences . .